

Attorney Docket No.:	DC0266US.NP
Inventors:	Kitareewan, et al.
Serial No.:	10/564,070
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REMARKS

Claim 8 is pending in this application. Claim 8 has been rejected. Claim 8 has been amended. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the following remarks.

I. Rejection Under 35 U.S.C. §103

Claim 8 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Bard et al. (1977) in view of Yoshida et al. (1996) as evidenced by Adamson (1996) for the reasons of record.

Applicants respectfully disagree with this rejection. Applicants have identified a unique pathway for increasing the degradation of an oncogenic protein, i.e., destabilizing lysosomes. In this respect, pages 4-12 describe a number of specific agents including arsenic, chloroquine, and retinoic acid, as well as other test agents that can be screened in accordance with the instant assay. While the Office asserts that the combined teachings of Bard et al. and Yoshida et al. suggest a screen using retinoic acid, Applicants respectfully assert that these references do not teach or suggest other test agents. Therefore, in an earnest effort to facilitate the prosecution of this application and provide for the identification of new agents for destabilizing lysosomes and increasing oncogenic protein degradation, Applicants have amended claim 8 to specify that the agent is not retinoic acid. Support for this amendment is found in pages 4-12, which list various agents of use in the instant method. In so far as it is not new matter to

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remove one species from a list¹, and the combined teachings of the cited references fail to teach other agents of use in the instant method, Applicants respectfully request that this rejection be reconsidered and withdrawn.

II. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Advisory Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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¹MPEP 2173.05(i) states: If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining.").